

REMARKS

The indication of allowable subject matter in claims 4, 16 and 17 is acknowledged and appreciated. In view of the following remarks, it is respectfully submitted that all claims are in condition for allowance.

Claims 1 and 7 are independent and stand rejected under 35 U.S.C. § 103 as being unpatentable over newly cited Tanabe et al. '520 ("Tanabe") in view of EP '030. This rejection is respectfully traversed for the following reasons.

Each of claims 1 and 7 embodies at least one insulating holder that includes *a penetration hole* to which the airtight container is inserted. In contrast, the alleged insulating holder 6, 21 of Tanabe is merely a dielectric sheet bent into a U-shape without any holes to which the container 1 is inserted. The Examiner appears to interpret broadly the space between opposing sides of the U-shape as a "hole" of the insulating holder. It is respectfully submitted however that this interpretation is unreasonable and inconsistent with the plain and ordinary meaning of the term "hole."

As defined in the Merriam-Webster Online Dictionary, a hole is "an opening *through* something" (emphasis added). One exemplary embodiment of such a configuration is shown in Figure 2 of Applicants' drawings, in which the exemplary penetration hole 21 is an opening which extends through the holder 20. Whereas, in Tanabe, the alleged "hole" is in fact merely a space defined by opposing sides of a bent U-shaped dielectric sheet. The alleged "hole" of Tanabe is not an opening which extends *through* any physical part of the alleged holder 6, 21.

Similarly, if one were to fold a sheet of paper into a U-shape, the space defined between the sides of the U-shape can not reasonably be interpreted as an opening through *the paper itself*.

That is, the paper itself has no opening therethrough required by a “hole” as defined in Applicants’ specification consistently with its plain and ordinary dictionary meaning.

Moreover, this distinction between the claimed “hole” of the present invention and hole-less U-shape of Tanabe is important. Specifically, as the U-shape does not restrict movement of the container toward the open end, movement of the container 1 of Tanabe will change the distance between the container 1 and the electrode 4 so that discharging becomes unstable. Only Applicants have recognized and considered this drawback of conventional design, and conceived of a novel and non-obvious “hole” configuration which can make it possible to obviate said drawbacks. In this regard, by using an insulating holder that includes *a penetration hole* to which the airtight container is inserted, the claimed arrangement can make it possible for the container to not move relative to an external electrode so that discharging can be made stable.

In addition to the aforementioned distinction, with respect to claim 7, the Examiner admits that the cited prior art further does not suggest the particular location of the reflection member but alleges that positioning of the reflection member would have been obvious based on case law related to rearrangement of parts. In this regard, though not cited by the Examiner, the case law by which the Examiner makes his assertion is presumably *In re Japikse*. It is respectfully submitted that the Examiner’s reliance thereon is misplaced. Specifically, the holding in *In re Japikse* is based on the requirement that the rearrangement of parts would not have modified the operation of the device. In contrast, in the instant case, when a reflection member is internally provided relative to the second electrode as disclosed by EP ‘030, the resulting structure effects a configuration in which light can only be emitted from a portion other than the reflection member. In contrast, according to the present invention, when a reflection member that both includes an

opening through which light emitted from the airtight container is emitted *and* that is externally provided relative to the second electrode, the distance between the container and second electrode is narrower whereby the discharge medium can be sufficiently excited without generating ozone. In addition, such a configuration can also make the distance between the container and the reflection member wider so that light reflects from the container more efficiently.

Accordingly, the operation of the device will be modified according to the location of the reflection member thereby distinguishing this case from that in *In re Japikse*, so that the holding in *In re Japikse* is not applicable to the present application.

Furthermore, even assuming *arguendo* the rearrangement of the reflection member does not modify operation, the Examiner must still provide motivation outside of Applicants' specification to support the modification. **In the instant case, the Examiner has not satisfied this requirement as the Examiner makes no statement purporting a motivation to make the modification.** The Examiner is directed to MPEP § 2144.04(VI)(C). "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, *without the benefit of appellant's specification*, to make the necessary changes in the reference device" (emphasis added). *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Only Applicants have recognized and considered the issues related to the location of a reflection member relative to the second electrode, and conceived of the novel and non-obvious combinational arrangement which can make it possible to obviate such issues.

Based on the foregoing, it is submitted that the location of the reflection member can not simply be discounted as obvious based on case law, as the Examiner has not satisfied either of the two requirements set forth in *In re Japikse*. Moreover, the claimed location of the reflection member as set forth in the particular combination can effect new and unexpected results relative to the cited prior art, thereby evidencing criticality thereof.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

For example, none of the cited prior art disclose or suggests "wherein the reflection member is provided at three surfaces of the at least one insulating holder at which no empty section is formed or at only one surface of the at least one insulating holder which is opposite to the empty section" as recited in claim 19. Support for this feature can be found on page 20, lines 7-9 of Applicants' specification.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.


CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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